No. 91-157

IN THE
Supreme Court of the United States
OCTOBER TERM, 1991

TANDON CORPORATION,
Petitioner,
vs.
QUANTUM CORPORATION,
Respondent.

PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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No. 91-157

In The
SUPREME COURT OF THE UNITED STATES
October Term, 1991

TANDON CORPORATION,
Petitioner,
vs.
QUANTUM CORPORTION,
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

The relevant opinions below are set forth at page 1 of Tandon Corporation's ("Tandon" or "Petitioner") Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit, No. 91-157 ("Petition").

JURISDICTION

The relevant jurisdictional history is set forth at Petition, page 2. The Petition was received on July 29, 1991. This opposition is timely filed under Supreme Court Rules, Rule 15.2.

STATUTES INVOLVED

The relevant statutory provisions, 28 U.S.C. § 1291 and 1295(a)(1), are set forth at Petition, pages 2 - 3.

SUMMARY OF THE REASONS THE PETITION SHOULD BE DENIED

The "Questions Presented" in the Petition in this case (Petition, p. i) are, remarkably enough, *not* presented by the present case itself. The appeal dismissed by the Federal Circuit in the present case was from a District Court ruling which did not even come close to presenting a close question of finality, but the Questions Presented pluck language from *Gillespie v. United States Steel Corp.*, 379 U.S. 148, 152 (1964) which, read in context, relates to cases which are in "the 'twilight zone' of finality" (*Gillespie*, 379 U.S. 152) and in which the issue of whether a district court decision is final under 28 U.S.C. § 1291 is "so close a question that decision of that issue either way can be supported with equally forceful arguments" (*Gillespie*, at 379 U.S. 152).

In stark contrast, the present case involves dismissal of an attempted appeal from a grant of partial summary judgment eliminating two of more than ten affirmative defenses raised by Petitioner and from denial of a partial summary judgment to Petitioner on another of its affirmative defenses. Respondent's principal claim for patent infringement and Petitioner's multiple remaining defenses remain for trial on the merits. Thus, the rulings appealed from are not even remotely final and, far from being in a "twilight zone" of finality, are clearly illuminated by the sunshine of sound reason as rulings whose clear-cut *nonfinality* cannot be rationally questioned. Petitioner's effort to use *Gillespie* as a basis for

appealability is, accordingly, a serious distortion of the holding in that case.

If the "practical rather than technical construction" recommended in *Gillespie* for the term "final decision" in 28 U.S.C. § 1291 is used, this nonfinality and non-appealability is equally clear. Petitioner is a patent infringement defendant which has asserted multiple affirmative defenses. Disposition, by way of grant of partial summary judgment, of one or two of those defenses does not (once again, in fundamental contrast to *Gillespie*) create any risk of loss of right, it merely narrows the issues to be tried. To permit appeals from such interlocutory rulings on motions for partial summary judgment would be to open the floodgates to piecemeal appeals.

This Court held, in *Firestone Tire & Rubber Co. v. Risjord*, 449 U.S. 368, 374 (1981) that requiring a party to await a final decision and to raise all claims of error in a single appeal "avoid[s] the obstruction to just claims that would come from permitting the harassment and cost of a succession of separate appeals" and "promot[es] efficient judicial administration." This was, implicitly, the eminently practical construction given to the finality requirement of Section 1291 by the Federal Circuit in the present case.

In dismissing Petitioner's appeal of the District Court Order, the Federal Circuit applied well-settled law holding that it did not have jurisdiction over a denial of partial summary judgment nor over a grant of partial summary judgment because they were not final orders under 28 U.S.C. §§ 1291 and 1295(a) and were inherently interlocutory and not appealable. *Liberty Mutual Ins. Co. v. Wetzel*, 424 U.S. 737, 96 S.Ct. 1202, 47 L.Ed.2d 435 (1976). This rule of law established by this

Court is uniformly applied by all of the Circuit Courts of Appeals.

Tandon's Petition further asserts that the Federal Circuit, along with the Second, Fifth and Eighth Circuits, refuses to apply the *Gillespie* precedent to determine appealability. Petitioner's assertion is false. The Court of Appeals for the Federal Circuit,[1] as well as the Second, Fifth and Eighth Circuit Courts of Appeals, invariably applies the *Gillespie* precedent to finality determinations and has used it to find jurisdiction to hear an appeal from a decision of a district court where there is a close question as to that decision's finality and the other *Gillespie* factors are satisfied. However, when *Gillespie* is urged as a basis for appealability in a case in which it is not applicable, the Federal Circuit does not exercise appellate jurisdiction and the appeal is dismissed. The Second, Fifth and Eighth Circuits do the same. This is just what happened in the present case.

STATEMENT OF THE CASE

I.

INTRODUCTION

The Petition seeks to reinstate an attempted appeal of interlocutory decisions involving two of many defenses asserted to a charge of patent infringement. The issues to which the attempted, and dismissed, appeal was directed do not involve tensions between state and federal law and are not constitutional in character. The

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[1] *E.g.*, in *Tenneco Resins, Inc. v. Reeves Bros., Inc.*, 736 F.2d 1508 (Fed. Cir. 1984).

appeal was merely the attempt of an accused patent infringer to obtain premature review of adverse, interlocutory pretrial rulings in an ordinary patent infringement action.

The action below was filed by Quantum Corporation[2] against infringer Tandon Corporation alleging infringement of Quantum's U.S. Reissue Patent Re. 32,075.[3] In response to the complaint, Tandon denied the charge of infringement and separately raised more than ten affirmative defenses. Tandon subsequently moved for partial summary judgment of patent invalidity on the basis of two of its affirmative defenses. These motions asserted that the reissue oath submitted by the inventors was legally defective and that Quantum had not complied with the "best mode" requirement of 35 U.S.C. § 112.

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[2] Plus Development Corp., Inc., a fully owned subsidiary of Quantum, is still listed as a party to this action. The original action against Tandon included a claim of infringement of a patent owned by Plus. After Tandon agreed to cease manufacturing the accused devices, the parties settled with respect to the Plus patent.

[3] This is the fourth litigation involving Quantum's reissue patent. The first action, *Quantum Corporation v. CMI*, Civil Action No. 83-4969 PX, Central District of California, settled after the grant of the Reissue Patent by the Patent and Trademark Office with CMI agreeing to entry of a permanent injunction and paying Quantum $6,000,000.00 for past damages. The second action, *Quantum v. NEC et al.*, Civil Action No. 86-20072 SW, Northern District of California, settled after the district court granted Quantum's motion for partial summary judgment of infringement, with NEC agreeing to entry of permanent injunction and paying Quantum $2,975,000.00. The third action, *Quantum et al. v. Western Digital Corporation*, Civil Action No. 89-1856 WHO, Northern District of California, settled with Western Digital agreeing to entry of a permanent injunction and paying Quantum $2,500,000.00 for past damages. The Western Digital case had been consolidated with the present action with Tandon because Western's infringement stemmed from its purchase of Tandon's disk drive business.

Quantum cross-moved for summary judgment on Tandon's reissue oath defense.

II.

BACKGROUND OF THE ATTEMPTED APPEAL

In an order dated January 11, 1991, the district court denied Tandon's motion for summary judgment that Quantum's reissue oath was defective, and granted Quantum's cross-motion for partial summary judgment that the reissue oath was not defective. The district court also denied Tandon's motion for partial summary judgment based on best mode, finding that genuine issues of material fact existed as to the bulk of Tandon's best mode contentions (and ruled that one of Tandon's contentions was entirely baseless).[4] Tandon then attempted to appeal from these interlocutory decisions.

Neither of the district court's decisions on these motions came anywhere close to finally disposing of all the issues between the parties. Rather, the overwhelming majority of issues in the case, *i.e.*, Quantum's claim of patent infringement and Tandon's remaining multiplicity of asserted defenses, remain to be tried.

---

[4] Appendix to Petition pages 32a - 33a.

III.

THE DENIAL OF TANDON'S "BEST MODE" MOTION FOR PARTIAL SUMMARY JUDGMENT

Tandon's motion for partial summary judgment on "best mode" grounds asked the district court to invalidate some or all of the claims of the patent-at-issue because the inventors allegedly failed to disclose the best mode for practicing their invention as required by 35 U.S.C. § 112. Tandon claimed that partial summary judgment of invalidity of all claims was appropriate in the present case because the inventors allegedly failed to disclose five purported aspects of implementing "best mode." The district court *denied* Tandon's motion for partial summary judgment because it found with regard to four of these "best mode" aspects that genuine issues of material fact existed which had to be decided at trial by the trier of fact.[5] With regard to the remaining aspect raised by Tandon — the servo-writer aspect — the district court ruled that no genuine issue of material fact existed and narrowed the issues for trial by ruling in favor of Quantum.[6]

Tandon now asks this Court to direct immediate review by the Federal Circuit of the district court's servo-writer best mode determination, even though four other best mode issues raised by Tandon remain for trial.

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[5] Appendix to Petition, page 32a.

[6] For the servo-writer aspect, see Petition Appendix page 16a, "Therefore the Court finds that Quantum adequately disclosed the best mode for practicing its invention with respect to the servo-writer."

IV.

THE GRANT OF QUANTUM'S CROSS-MOTION FOR PARTIAL SUMMARY JUDGMENT

The granting of Quantum's cross-motion for partial summary judgment regarding sufficiency of the reissue oath in the patent in suit eliminated only one of Tandon's many stated affirmative defenses. The district court's decision on this issue of law relating to reissue oaths is limited to that particular affirmative defense and does not deprive Tandon of any fundamental right. After trial on the merits, Tandon will be able to appeal the district court's decision on the reissue oath.

THE REASONS WHY THIS CASE SHOULD NOT BE REVIEWED BY THIS COURT

I.

THE FEDERAL CIRCUIT HAS NOT DECIDED AN IMPORTANT QUESTION OF FEDERAL LAW IN A WAY WHICH CONFLICTS WITH APPLICABLE DECISIONS OF THIS COURT OR ANY OTHER CIRCUIT

At the core of Tandon's arguments in its Petition is its contention that the Federal Circuit limits appeals to orders terminating proceedings without considering whether *Gillespie* applies and thus is out of step with other circuits in application of the *Gillespie* precedent. The Petition contains absolutely no basis for this contention and, in any event, the present case could not

possibly serve as a vehicle for reviewing such a question because it totally fails to present a close question of finality which might be appealable under *Gillespie*. Rather, the nonfinality of the district court rulings in the present case is so plain that no *Gillespie* issue having any substance could be raised.

A. THE FEDERAL CIRCUIT CORRECTLY APPLIES *GILLESPIE*

Cases which present a genuine *Gillespie* issue, *i.e.*, cases in which the question of whether a district court decision was or was not final is extremely close, are exceedingly rare. This is, of course, because most district court decisions are either plainly final or, as in the present case, plainly nonfinal. However, under certain unusual circumstances, where a decision which has most of the attributes of finality, but as to which some type of technical question can be raised as to finality, and with regard to which nonappealability would raise a serious question of loss of right, the *Gillespie* decision gives appellate courts some narrowly circumscribed authority to accept an appeal without resolving a technical issue as to finality. The narrowness of these constraints is reflected in *Coopers & Lybrand v. Livesay*, 437 U.S. 463, 477, fn. 30 (1978) where this court held:

> "If *Gillespie* were extended beyond the *unique facts of that case*, § 1291 would be *stripped of all significance*." (emphasis added).

Viewed against this background, the application by the Federal Circuit of the *Gillespie* precedent is totally in accord with *Gillespie* itself and totally consistent with the interpretation of *Gillespie* in other circuits.

The Federal Circuit has, when circumstances warranted, applied *Gillespie* to find appellate jurisdiction, *e.g.*, *Tenneco Resins, Inc. v. Reeves Brother's, Inc.*, 736 F.2d 1508 (Fed. Cir. 1984), but has refused to permit piecemeal appeals from plainly nonfinal decisions, *e.g.*, in *Cabot Corp. v. United States*, 788 F.2d 1539 (Fed. Cir. 1986), in which the decision in *Gillespie* was thoroughly discussed, at 788 F.2d 1544, before dismissing and improvident appeal of a remand by the Court of International Trade to the International Trade Administration for further agency proceedings. Plainly, a remand by a lower court to an administrative agency for further agency proceedings has no attributes of finality and does not create any risk of loss of right. Such a decision raises no *Gillespie* issue at all. However, even though *Cabot*, on the one hand, and *Gillespie* and *Tenneco*, on the other hand, are worlds apart in their factual settings, Tandon makes the bold contention that *Cabot* "was the first indication that the Federal Circuit would no longer apply *Gillespie*" (Petition, p. 11, fn. 7).

The *only* basis offered for the notion that *Cabot* marked a turning point in the Federal Circuit is a *single* subsequent decision by the Federal Circuit three years later in *Copelands' Enterprises, Inc. v. CNV, Inc.*, 887 F.2d 1065 (Fed. Cir. 1989) which was an appeal from a plainly nonfinal agency decision which granted partial summary judgment as to some issues but denied partial summary judgment as to other issues which then remained for trial. The Federal Circuit expressly considered *Gillespie*, but considered it plainly inapplicable. Accordingly, the appeal was dismissed. As set forth in Section II and footnote 11 of this Opposition, this is precisely the same result which would have obtained in every other circuit if an appeal from partial grant and denial of summary judgment were attempted.

Further evidence of the Federal Circuit's sensitivity to the need to apply the *Gillespie* precedent to issues of appealability can be found in the *post-Cabot* decision in *Refac International, Ltd. v. IBM*, 798 F.2d 459, 460 (Fed. Cir. 1986) (which is *not* cited in the Petition) where rehearing on the issue of appealability of a non-final stay order was permitted to consider whether such an order might be appealable under *Gillespie* or other exceptions to the finality rule. The Federal Circuit adhered to its prior ruling dismissing the appeal and characterized Refac's argument that the order fell within one of the exceptions to the rule against appealing final orders as being on "the ragged edge of the penumbra surrounding legitimate advocacy," but made it plain that it would give careful consideration to even a flimsy *Gillespie* argument. *Refac* was decided several months *after Cabot* and squarely refutes Petitioner's argument that the Federal Circuit's decision in *Cabot* meant that it "would no longer apply *Gillespie*."

B. THE SECOND, FIFTH AND EIGHTH CIRCUITS ALSO STILL APPLY *GILLESPIE*

Just as the Federal Circuit is still applying *Gillespie*, the Second, Fifth and Eighth Circuit Courts of Appeals are also still applying *Gillespie* and find appealability of certain marginally final orders when the *Gillespie* guidelines warrant.[7]

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[7] *See, e.g., John Doe Corp. v. John Doe Agency*, 850 F.2d 105, 108 (2nd Cir. 1988) *cert. granted*, 489 U.S. 1009 (1989), *reh. denied*, __ U.S. __, 110 S.Ct. 884 (1990); *Federal Savings and Loan Ins. Corp. v. Tullos-Pierremont*, 894 F.2d 1469, 1475 (5th Cir. 1990); and,

(continued)

C. THE "CONFLICT" AMONG THE CIRCUITS IS THE RESULT OF A CAREFUL SELECTION OF OPINIONS AND IS ILLUSORY

To promote the appearance of a conflict among the circuits, Tandon carefully selects and cites only those cases where the Second, Fifth, Eighth and Federal Circuit Courts found the *Gillespie* exception inapplicable.[8] Tandon omits from its citation cases where appeal of district court decisions was accepted under *Gillespie*.[9] To enhance its illusion of a conflict among the circuits, Tandon also carefully selects cases from the remaining circuits where the *Gillespie* exception was found to be applicable. Tandon does not bring to the Court's attention the cases from these remaining circuits where *Gillespie* appeals were refused.[10]

A comparison between all of the Circuit Courts' rulings in which the *Gillespie* exception was found to be applicable and a comparison between rulings of all of the Circuit Courts in which the *Gillespie* exception was found not to be applicable reveals that in reality there is no conflict at all over the application of *Gillespie* among the circuits.

(ftn. continued)
Farmland Industries, Inc. v. Frazier-Parrot Commodities, Inc., 806 F.2d 848 (8th Cir. 1986).

8 Petition at pages 12 and 13.

9 See note 7 *supra*.

10 *See, e.g., Shrader v. C.I.R.*, 916 F.2d 361, 363 (6th Cir. 1990); *Harper v. Bowen*, 854 F.2d 678 (4th Cir. 1988); *Branson v. City of Los Angeles*, 912 F.2d 334, 336 (9th Cir. 1990); and, *Miscott Corporation v. Zaremba Walden Co.*, 848 F.2d 1190, 1193 (11th Cir. 1988).

II.

THE DISMISSAL OF THE APPEAL BY THE FEDERAL CIRCUIT WAS IN ACCORD WITH THE DECISIONS FROM THE OTHER CIRCUITS

Given the same set of facts at issue before the Federal Circuit, *i.e.*, the denial of a partial summary judgment and the grant of a partial summary judgment, none of the other circuits would have treated the rulings Tandon here complains of as "final." All of the circuits are in agreement that a grant of partial summary judgment is inherently interlocutory and not final.[11]

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[11] *Domegan v. Fair*, 859 F.2d 1059 (1st Cir. 1988); *Clark v. Kraftco Corporation*, 447 F.2d 933 (2nd Cir. 1971); *Leopold v. Fitzgerald*, 421 F.2d 838 (2nd Cir. 1970); *Jackson v. Hart*, 435 F.2d 1293 (3rd Cir. 1970); *Dilly v. S. S. Kresge*, 606 F.2d 62 (4th Cir. 1979); *Reliance Ins. Co. v. Luke*, 608 F.2d 1020 (5th Cir. 1979); *Foremost Sales Promotions, Inc. v. Director, Bureau of Alcohol, Tobacco and Firearms, et al.*, 812 F.2d 1044 (7th Cir. 1987); *Cohen v. Curtis Publishing Co.*, 333 F.2d 974 (8th Cir. 1964), *cert. denied*, 380 U.S. 921 (1965), *reh. denied*, 380 U.S. 989 (1965); *St. Mary's Health Center v. Bowen*, 821 F.2d 493 (8th Cir. 1987); *R.J. Wolf v. Banco Nacional de Mexico*, 721 F.2d 660 (9th Cir. 1983), *cert. denied*, 469 U.S. 1108 (1985); *Chacon v. Babcock*, 640 F.2d 221 (9th Cir. 1981); *Stewart Title and Trust v. Ordean*, 528 F.2d 894 (9th Cir. 1976); *Oppenheimer v. Los Angeles County Flood Control District*, 453 F.2d 895 (9th Cir. 1972); *United States v. Olavarrieta*, 812 F.2d 640 (11th Cir. 1987), *cert. denied*, 484 U.S. 851 (1987); *Aaro, Inc. v. Daewoo International Corp.*, 755 F.2d 1398 (11th Cir. 1985); *Syntex Pharmaceuticals Int'l. Ltd. v. K-Line Pharmaceuticals Ltd.*, 905 F.2d 1525 (Fed. Cir. 1990).

III.

THE PRESENT APPEAL DOES NOT FALL WITHIN THE *GILLESPIE* EXCEPTION

There is not even remote similarity between the present case and *Gillespie*, and the Federal Circuit was correct in ruling that the *Gillespie* exception does not apply to the nonfinal decisions Tandon attempted to appeal from.

Gillespie dealt with a question of national importance involving the interplay of State and Federal law, namely whether the Jones Act precluded a claim for wrongful death under state law. The present case deals solely with a question of the application of Federal patent law to particular facts.

In *Gillespie*, the cause of action was dismissed on procedural grounds, preventing the *Gillespie* plaintiffs from their day in court. In the present case, Tandon will have opportunity for a full hearing on the merits of its defenses other than the limited issues decided adversely to it on partial summary judgment. Further, the delay in waiting until a full trial on the merits in *Gillespie* would have, in effect, resulted in a denial of the relief sought. Here, Tandon, a defendant, risks no loss of any right. The issues raised by its improper attempted appeal will be available to be raised in any appeal it may take after a trial on the merits.

In contradiction, the present case raises matters of essentially private importance to the parties to this case, one of whom (Petitioner) is a hold-out infringer who continues to litigate after (see footnote 3 hereof) three other infringers settled for an aggregate amount of just

under $11,500,000 and accepted permanent injunctions against further infringement. Indeed, Petitioner's tactics of taking premature appeals[12] and petitioning to this Court serve no purpose other than delaying proceedings in the trial court.

CONCLUSION

This case involves nothing more than a premature appeal by a dissatisfied litigant, which appeal was correctly dismissed by the Federal Circuit. No issue worthy of this Court's attention has been raised.

Respectfully submitted,

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[12] Petitioner, subsequent to the attempted appeal to which its present Petition is directed, attempted to appeal from another interlocutory decision of the district court (a discovery order) and that attempted appeal was dismissed on July 31, 1991 by the Federal Circuit for lack of appellate jurisdiction, *Quantum Corp. v. Tandon Corp.*, __ F.2d __ (Fed. Cir. 1991) (Appeal No. 91-1296, Dismissal Order). Petitioner has now moved for rehearing in the Federal Circuit in Appeal No. 91-1296.